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| 09/824,430 | 04/02/2001 | Luther Jackson | GE-07043 | 8163 |
| 28581 | 7590 | 09/15/2005 | EXAMINER | |
| DUANE MORRIS LLP PO BOX 5203 PRINCETON, NJ 08543-5203 | | | MEINECKE DIAZ, SUSANNA M | |
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3623

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,430

Applicant(s)

JACKSON ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed June 29, 2005.

Claim 1 has been cancelled.

Claims 2-4 have been added and are presented for examination.

2. The previous objection to the abstract is withdrawn in response to Applicant's submission of a corrected abstract.

The previous claim objection is moot in light of the cancellation of claim 1.

Response to Arguments

3. Applicant's arguments filed June 29, 2005 have been fully considered but they are not persuasive.

Applicant states, "One or more of the steps recited in each of claims 2-4 may be performed by a computer but are not limited thereby. For a claimed computer-related process to be statutory, the claimed process must either: A) result in a physical transformation outside the computer..., or B) be limited to a practical application within the technological arts... Claims 2-4 meet condition A because they involve a physical transformation outside the computer... Claims 2-4 also meet condition B because they are limited to a practical application in the lifetime support and depot operations art." (Page 8 of Applicant's response) By Applicant's own admission, the claims are not limited to being performed by a computer. As a matter of fact, there is no computer or

machine recited in claims 2-4 at all; therefore, the claims are not expressly or inherently computer-related and Applicant's aforementioned analysis is moot.

Applicant also argues that "the law does not require the terms 'computer' or 'processor' to be recited in a process claim to qualify the claim as statutory." (Page 8 of Applicant's response) Applicant cites a digital filtering process example from MPEP 2106, which is asserted to be statutory. The Examiner agrees with these statements; however, Applicant's claims do not recite any sort of technology. A digital filtering process requires electronic technology to remove the noise from a digital signal. Conversely, Applicant's own claims could be performed entirely by a human being without any technological assistance (i.e., the human being does not expressly or inherently utilize the assistance of a computer, physical machine, etc.). The claims are given their broadest, reasonable interpretation; therefore, Applicant must sufficiently amend technology into the claims with support from Applicant's specification for doing so.

Applicant argues that Applicant's Background section does not teach or suggest "a change document generating step," "the step of selecting a most remote one of the determined arrival dates as an integrated logistic support date," or "the step of comparing the ILS date with the selected ship upgrading date." (Page 9 of Applicant's response) The Examiner respectfully disagrees. Regarding "a change document generating step," Applicant's Background states that upgrades require changes in documents, such as technical manuals (page 4, lines 12-26 of the specification).

As per “the step of selecting a most remote one of the determined arrival dates as an integrated logistic support date,” in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). This limitation was address in the discussion of Official Notice in the previously pending (and currently revised) art rejection. Applicant has not addressed the Examiner's statement of Official Notice (which is consequently established as a fact of record since Applicant has not seasonably traversed the statement).

Regarding “the step of comparing the ILS date with the selected ship upgrading date,” this step was only recently incorporated into the claims and will be addressed in the revised art rejection found below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 2-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, while claims 2-4 produces a useful, concrete, and tangible result, they do not incorporate technology; therefore, claims 2-4 are non-statutory. In order to overcome this rejection, at least one of the core steps of the invention (e.g., a calculation or analysis step) should be expressly recited as performed by technology (e.g., a computer or processor), if supported by Applicant’s originally filed disclosure.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The next to last step of claim 3 recites that the most remote one of the determined arrival dates is selected as an integrated logistic support (ILS) date;

however, the last step of claim 3 recites that the ILS date is compared to the selected date. If the selected date was already set as the ILS date in the next to last step of claim 3, then why would further comparison be performed? For examination purposes, the Examiner will assume that, by setting the ILS date as the selected date, an inherent comparison is performed between the two dates.

Claim 4 is dependent from claim 3 and therefore inherits the same rejection.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (as disclosed in the "Background of the Invention" on pages 1-5 of the specification).

Applicant's admitted prior art discloses a method for determining whether a ship upgrade can commence on a selected date, said method comprising the steps of:

[Claim 3] generating a change document in response to a perceived problem associated with a particular type of equipment (Page 1, lines 9-12; Page 4, lines 12-26);

associating said change document with a ship having said particular type of equipment (Page 4, line 23 through Page 5, line 4 -- The Background of the Invention

acknowledges that, while this is a difficult task, it needs to be, i.e., has been already been, performed);

associating a particular upgrade with the change document (Page 4, lines 12-15);
determining arrival dates of all elements associated with the particular upgrade assigned to the change document (Page 3, lines 9-19);

[Claim 4] obtaining a promised delivery date for delivering an upgrade parts kit (Page 3, lines 9-19).

Regarding claims 3 and 4, while Applicant's admitted prior art does not expressly state that the ILS date for a selected ship upgrade is set as the promised date (i.e., arrival date) which is most remote in time, Applicant's admitted prior art does essentially state that an upgrade cannot be officially completed until all upgrade requirements are met (i.e., all parts required for upgrade are received, all technical manuals are updated, etc.):

... At some point in the accumulation process, lifetime support and depot operations collaborate on the status of critical logistical elements, which indicate what particular components of the necessary alteration kit or kits have been delivered, but as to undelivered materials, has only a manufacturer's promised delivery date upon which to rely. The scheduling of the upgrade is, of course, based upon the promised delivery dates. If these dates are not met, the materials cannot be shipped to the upgrade site so as to arrive in time for the scheduled starting date. the materials do not arrive on the manufacturer's promised date, then, the upgrade cannot begin, and the upgrade site, as for example a dry-dock, has a ship sitting therein on which work cannot be started, at least as to the missing alteration kits. Such late-arriving alteration kits can be stored until a later

Art Unit: 3623

scheduled upgrade time, possibly years in the future, but cannot be installed during this particular scheduled upgrade interval...

Each ship upgrade requires upgrading of the technical manuals associated with the upgraded equipment so that the upgraded equipment may be properly maintained. If the technical manual is classified, it must be treated differently than spare parts. Documentation must be provided for the handling of the technical manuals, and their arrival in time for the upgrade must be considered. (Page 3, lines 9-32; Page 4, lines 12-20)

Since Applicant's admitted prior art acknowledges that an upgrade cannot be officially completed until all upgrade requirements are met (i.e., all parts required for upgrade arrive, all technical manuals are updated, etc.) and that scheduling is typically based on the promised delivery dates of materials required to perform the upgrade, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to perform with the prior art method of selecting a ship upgrade, selecting that one of said promised dates which is most remote in time and deemed said one of said promised dates (i.e., arrival dates) to be said ILS date (which inherently includes comparing the ILS date with the selected date) in order to help ensure that the ILS date is reasonably set at a time when all upgrade requirements will have been met (i.e., all parts required for upgrade will have arrived, all technical manuals will have been updated, etc.). Similarly (regarding claim 4), the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to compare the promised delivery date with the selected date in order to further ensure that all upgrade parts will be delivered on time.

(Please note that the Examiner understands that Applicant's intended invention is meant to address an improved method for determining "the status of accumulation of the necessary equipments for an upgrade of a major asset" (page 5, lines 10-13 of the specification); however, the details of such an improved method have not been clearly expressed in the claimed invention.)

[Claim 2] Claim 2 recites limitations already addressed by the rejection of claim 3 above; therefore, the same rejection applies.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3623

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

September 11, 2005